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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/810,084 03/16/01 NELSON

M NLN 301

EXAMINER

MM91/0926

KOLISCH, HARTWELL, DICKINSON,
MCCORMACK & HEUSER
200 PACIFIC BUILDING
520 S.W. YAMHILL STREET
PORTLAND OR 97204

JAGAN, M

ART UNIT

PAPER NUMBER

2859

DATE MAILED:

09/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/810,084

Applicant(s)

NELSON ET AL.

Examiner

Mirellys Jagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/16/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "56" in figures 1-3, and "68" and "70" on page 12, lines 18-19, figure 5. Correction is required.

Specification

2. The disclosure is objected to because of the following informalities:
"86b" on page 13, line 22 should be changed to --86c--.
3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 3 and 9 recite the limitation "curves" in line 3 of each claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

4. Claim 8 and 18 is objected to because of the following informalities:
 - a. Claim 8 recites the limitation "said perimeter structure" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.
 - b. Claim 18: "place" should be changed to --plane-- on line 3.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 7-8, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,458,946 to White, Jr. [hereinafter White] in view of U.S. Patent 1,303,756 to Ballou.

White discloses a detachable workpiece-gripping device joinable to a measuring tape outer end. The device comprises a gripper body (catch assembly 20), having a generally planar and circular body expanse (back 22), with an annular perimeter structure (retainer ring 24). The device is mounted to the tape's outer end such that the perimeter structure extends toward the tape (see figure 1, column 2, lines 65-67, and column 3, lines 1-20) and is located in a circumsurrounding fashion relative to the tape's nominal plane.

White does not disclose a mounting structure joined to the body expanse, and the device having plural, spaced, perimeter-distributed, workpiece-gripping, and tooth-like projection elements located on a perimeter structure in spaced relation to opposite sides of the tape's nominal plane, with the elements extending toward the tape.

Ballou discloses a device (attachment) having plural, spaced, perimeter-distributed, workpiece-gripping projection elements (teeth) located on the gripping body (members 5 and 6) in spaced relation to opposite sides of the tape's nominal plane, with the elements extending toward the tape when the device is attached, using a detachable mounting structure (body 1), on the tape's outer end (see figure 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by White by adding mounting means to the body, and projection elements, as taught by Ballou, to the perimeter structure in order for the tape to attach to the device, and the device then grasp a workpiece surface more securely while taking measurements.

7. Claims 3-6, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over White and Ballou as applied to claims 1-2, 7-8, 13 above, and further in view of U.S. Patent 5,894,677 to Hoffman.

With respect to claims 4-6, 10, and 11: White and Ballou disclose all of the limitations of claims 4-6, 10, and 11 except for the mounting structure being in the form of a detachable snap-capture arrangement forming a channel to receive and lock into a tape's outer end structure, the structure having a lateral projection, which extends laterally at an angle relative to the plane of the tape.

Hoffman discloses a device (extension 754) having a mounting structure (slot 758) in the form of a detachable snap-capture arrangement forming a channel to receive and lock into a tape's outer end structure, the structure having a lateral projection, which extends laterally at an angle relative to the plane of the tape (see figures 10 and 11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by White and Ballou by adding a mounting means to the body, as taught by Hoffman, in order for the device to detachably receive and lock into a tape's lateral outer end structure when taking measurements.

With respect to claims 3 and 9: White and Ballou disclose all of the limitations of claim 3 and 9, except for the body expanse having a polygonal shape.

Hoffman discloses a device (tabs) having different polygonal shaped body expanses (see figures 7, 8, and 14).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shape of the body expanse taught by White and Ballou by making it of a polygonal shape, as disclosed by Hoffman, in order for the device to extend in at least two directions traverse to the surface of the tape, thereby enabling the device to grasp onto a surface along its lateral edges (see column 7, lines 25-29). Furthermore, with respect to claims 3 and 9: the shape of the body expanse, i.e., polygonal-shape, absent any criticality, is only considered to be an obvious modification of the shape of the body expanse disclosed by White and Ballou as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art, as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

8. Claims 12 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman in view of U.S. Patent 1,542,990 to DiTomaso.

Hoffman discloses a device including all of the limitations of claims 12 (see figures 10 and 11), 14 (see figure 9), 15 (see figure 9), 16 (see figure 9), and 17 (see figures 10 and 11) except for:

Claims 12 and 17: the gripper body having plural, spaced, distributed, workpiece-gripping projection elements that extend toward the tape;

Claim 14: the gripper body having plural, arcuate, linearly distributed workpiece-engaging projection elements arranged in a two-dimensional, long-path array, where the projection elements extend toward the tape and are deployed along a curved line, which resides generally entirely on the non-indicia side of the tape;

Claim 15: the gripper body having plural, linearly distributed workpiece-engaging projection elements arranged in at least two, spaced, arcuate linear arrays, where the projection elements straddle the tape's nominal plane in two, laterally-spaced regions located near the tape's lateral edges, and extend toward the tape;

Claim 16: the gripper body having plural, arcuate, linearly distributed workpiece-engaging projection elements arranged in a two-dimensional, long-path array, where the projection elements are located on, and in spaced relation to, opposite sides of the tape's nominal plane, and extend toward the tape;

DiTomaso discloses a device with a gripper body (lug 9) having plural projection elements (toothed surface 10) that extend toward the tape (see figure 2).

Referring to claims 12 and 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Hoffman by adding the projection elements taught by DiTomaso to the gripper body in order for the device to grasp a workpiece surface more securely when taking measurements.

Referring to claims 14-16, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Hoffman by adding the

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projection elements taught by DiTomasso to the gripper body in order for the device to allow visibility of the indicia when taking measurements and grasp a workpiece surface more securely along the surfaces and sides of the tape. Changing the location of the projection elements from the location shown by Hoffman and DiTomasso to a location on the non-indicia side of the tape or the lateral sides, absent any criticality, is only considered to be an obvious modification of the device disclosed by Hoffman and DiTomasso that a person having ordinary skill in the art at the time the invention was made would be able to provide using routine experimentation since the courts have held that there is no invention in shifting the position if the operation of the device would not thereby be modified. In re Japikse, 86 USPQ 70 (CCPA 1950).

With respect to claims 14-16: the shape of the linear array of the projection elements, i.e., arcuate, absent any criticality, is only considered to be an obvious modification of the shape of the projection elements disclosed by DiTomasso as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See In re Dailey, 149 USPQ 47 (CCPA 1976).

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and DiTomasso as applied to claims 12 and 14-17 above, and further in view of U.S. Patent 6,115,931 to Arcand.

Hoffman and DiTomaso disclose all of the limitations of claim 18 except for the mounting structure including a swing tab that allows the device to swivel about an axis, which is generally normal to the plane of the tape.

Arcand discloses a device (adapter assembly) having a swiveling mounting structure attachable to the end of a measuring tape (see figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Hoffman and DiTomaso by adding swiveling capabilities to the mounting structure, as taught by Arcand, in order to allow rotational movement of the gripping device when taking measurements.

10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman and DiTomaso as applied to claims 12 and 14-17 above, and further in view of U.S. Patent 5,600,894 to Blackman.

Hoffman and DiTomaso disclose all of the limitations of claim 19 except for the gripping device having a soft-surface attachment that is removably attached to the gripper body.

Blackman discloses a gripping device (hooking device 10) for a tape measure having a soft-surface material (bumper 180) removably attached to the gripper body (see figure 12 and column 3, lines 63-67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device disclosed by Hoffman and DiTomaso by adding a removable soft-surface material, as taught by Blackman, to the gripper body in order to prevent the teeth from scratching a workpiece surface.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patent discloses a toothed end piece attachment for a tape measure:


U.S. Patent 1,102,436 to Richardson

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mirellys Jagan whose telephone number is 703-305-0930. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on 703-308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7725 for regular communications and 703-308-7725 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

mj
September 25, 2001


Diego Gutierrez
Supervisory Patent Examiner
Technology Center 2800